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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/761,869	01/21/2004	Pekka Laukkanen	LEIT 0101 PUSA1	3141

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EXAMINER

LAVILLA, MICHAEL E

ART UNIT	PAPER NUMBER
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1775

DATE MAILED: 04/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/761,869

Applicant(s)

LAUKKANEN ET AL.

Examiner

Michael La Villa

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☐ Certified copies of the priority documents have been received.
 - 2) ☒ Certified copies of the priority documents have been received in Application No. 10/177,644.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>20040429</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Specification

1. Applicant is reminded of the proper content of an abstract of the disclosure.
2. A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.
3. The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.
4. Where applicable, the abstract should include the following:
 - (1) if a machine or apparatus, its organization and operation;
 - (2) if an article, its method of making;
 - (3) if a chemical compound, its identity and use;
 - (4) if a mixture, its ingredients;
 - (5) if a process, the steps.
5. Extensive mechanical and design details of apparatus should not be given.
6. The abstract of the disclosure is objected to because it does not describe the invention as now claimed. Correction is required. See MPEP § 608.01(b).
7. The disclosure is objected to because of the following informalities: The first sentence of the specification pertaining to the priority application should be updated to reflect the issued patent number for that application.
8. Appropriate correction is required.

Claim Rejections - 35 USC § 112

9. The following is a quotation of the first paragraph of 35 U.S.C. 112:
10. The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
11. Claims 1-16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. It is unclear where applicant describes the invention as now claimed in the originally filed Specification and claims. Particularly, it is unclear where the limitation pertaining to absence of adhesive material is taught. It is also unclear how the originally filed Specification and claims would otherwise convey to one of reasonable skill in the art that applicant, at the time of original filing, had possession of the invention as now claimed.
12. The following is a quotation of the second paragraph of 35 U.S.C. 112:
13. The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
14. Claims 10-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
- I. Regarding Claims 10-16, the respective preambles refer to “coated composite cylinder” rather than “machine for making

paper" as provided for in the independent claim. Hence, it is unclear what is the scope of the claimed invention in these dependent claims.

Claim Rejections - 35 USC § 102

15. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

16. A person shall be entitled to a patent unless –

17. (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

18. Claims 1-3, 5, 7, and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Sigrf Electrographit G 84 06019.0. The reference teaches a carbon fiber composite roll that is coated with copper and then coated with chromium. See Sigrf Electrographit (page 4, lines 4-7; page 5, lines 3-17; and Figures 1 and 2).

19. Claims 1, 2, 5, 7, and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Hashimoto EPA 0 461 253. Hashimoto teaches a fiber composite roll that is coated with a metal layer and a hard chromium layer. See Hashimoto (Abstract; col. 2, line 31 through col. 3, line 15; col. 4, lines 25-43; and Figures 1 and 4).

Claim Rejections - 35 USC § 103

20. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

21. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

22. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over

Hashimoto EPA 0 461 253. Hashimoto teaches a fiber composite roll that is coated with a metal layer and a hard chromium layer. See Hashimoto (Abstract; col. 2, line 31 through col. 3, line 15; col. 4, lines 25-43; and Figures 1 and 4).

Hashimoto may not exemplify using carbon fiber, but suggests that carbon fibers may be used. It would have been obvious to one of ordinary skill in the art at the time of the invention to utilize carbon fiber reinforcement as Hashimoto suggests that such reinforcement material is effective.

23. Claims 9-13, 15, and 16 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Sigrf Electrographit G 84 06019.0 in view of Applicant's Admissions. The reference teaches a carbon fiber composite roll that is coated with copper and then coated with chromium. See Sigrf Electrographit (page 4, lines 4-7; page 5, lines 3-17; and Figures 1 and 2). The reference does not exemplify using the roll in a paper making apparatus, but teaches that the rolls are useful for general roll applications. Applicant's Admissions teach that rolls are conventionally used in a paper making apparatus. See Specification

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(paragraph bridging pages 1 and 2). It would have been obvious to one of ordinary skill in the art at the time of the invention to use the roll of Sigr Electrographit in a paper making apparatus, which is described by Applicant's Admissions as being a conventional area for the use of rolls, since Sigr Electrographit teaches that the rolls are useful for general roll applications, which includes conventional areas such as paper making.

Conclusion

24. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael La Villa whose telephone number is (571) 272-1539. The examiner can normally be reached on Tuesday, Thursday, and alternating Fridays.
25. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Jones can be reached on (571) 272-1535. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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26. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Michael La Villa
2 April 2005

